

## **REMARKS**

In the non-final Office Action dated March 31, 2008, it is noted that claims 1 – 35 are pending.

In the present amendment, claims 1, 24 and 33 are amended to more clearly and distinctly claim the subject matter that Applicant regards as his invention. No new matter has been added.

### **Rejections under 35 U.S.C. §102**

Claims 1 – 2, 4, 9 – 15, 20 – 22, 24 – 31, 33 and 35 are rejected under 35 U.S.C. §102(b) as being anticipated by Katabami (US 5,528,002).

### **Rejections under 35 U.S.C. §103**

Claims 5 – 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Katabami in view of Yamanami et al. (US 4,902,858).

Claims 7 – 8, 19 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Katabami in view of Ely et al. (US 6,667,740).

Claims 3, 16 – 17 and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Katabami in view of Stein et al. (US 5,365,461).

Claims 16 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Katabami in view of Teterwak et al. (US 5,777,898).

Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ely et al. (US 6,667,740) in view of Katabami and further in view of Colgan et al. (US 6,204,897).

### **Response to Arguments**

Applicant submits that for at least the following reasons, claims 1 – 2, 4, 9 – 15, 20 – 22, 24 – 31, 33 and 35 are not anticipated by Katabami.

For example, amended claim 1 requires:

*“means for coupling to ground along substantially the length of the user-holdable device.”*

Support for the above features may be found in Applicant's specification, for example, Fig. 9 and page 21, lines 1 – 17.

As noted in the Office Action, page 4, Katabami discloses that the ground coupling is merely a ring around the end of the stylus and does not span the entirety of the stylus. Therefore, Katabami does not teach or suggest any “*means for coupling to ground along substantially the length of the user-holdable device,*” as claimed.

In view of the foregoing, Applicant submits that claim 1 is patentable over Katabami. Claim 24 should also be patentable as it contains many similar distinguishing features as discussed in claim 1. Claims 2 – 23 and 25 – 32 are believed to be patentable because they respectively depend from claims 1 and 24, with each claim containing further distinguishing features. Withdrawal of the rejection of claims 1 – 2, 4, 9 – 15, 20 – 22, 24 – 31 under 35 U.S.C. §102(b) is respectfully requested.

Moreover, Applicant's amended claim 33 recites:

*“sensing, by time-multiplexing, the output when the user-held device is positioned or moved such that the conducting tip is in the vicinity of a sensing means, or when a user's finger is positioned or moved such that the user's finger is in the vicinity of the sensing means;*

*wherein said time-multiplexing provides a means for distinguishing between sensing of the user's finger and sensing of the user-holdable device.”*

Support for the above features may be found in Applicant's specification, for example, Fig. 7 and page 15, lines 4 – 12.

In the Office Action, page 12, it is conceded by the Office that Katabami does not disclose a means for sensing a user's finger. Therefore, Katabami does not anticipate amended claim 33. Claim 35 should also be patentable because it depends from claim 33 with further distinguishing features. Withdrawal of the rejection of claims 33 and 35 under 35 U.S.C. §102(b) is respectfully requested.

Although the secondary reference, Stein, cited by the Office appears to disclose a user input device comprising a means for both sensing a user's finger and a stylus, Applicant submits

that Stein does not disclose any sensing by time-multiplexing. Therefore, Stein fails to teach or suggest “*sensing, by time-multiplexing, the output when the user-held device is positioned or moved such that the conducting tip is in the vicinity of a sensing means, or when a user’s finger is positioned or moved such that the user’s finger is in the vicinity of the sensing means,*” as claimed. Therefore, Stein does not bridge the feature gap between Katabami and the claimed invention.

Applicant further submits that none of the cited secondary references, Yamanami, Ely, Stein, Teterwak, or Colgan, can cure the defects found in Katabami as pointed out above. Therefore, claims 3, 5 – 8, 16 – 19, 23; 32 and 34 should also be patentable because they respectively depend from claims 1, 24 and 33, with each claim containing further distinguishing features. Withdrawal of the rejection of claims 3, 5 – 8, 16 – 19, 23, 32 and 34 under 35 U.S.C. §103(a) is respectfully requested.

### **Conclusion**

In view of the foregoing, it is respectfully submitted that all the claims pending in this patent application are in condition for allowance. Reconsideration and allowance of all the claims are respectfully solicited.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 14-1270.

Respectfully submitted,

By: /Brian S. Myers/  
Brian S. Myers  
Registration No.: 46,947  
For: Larry Liberchuk  
Registration No.: 40,352

**Please Address All Correspondence to:**  
Larry Liberchuk, Registration No. 40,352  
Phone: (914) 333-9620  
CUSTOMER NUMBER 24737